

REMARKS

The claims of this application have been amended to overcome the rejections under 35 U.S.C. §101 and §112, second paragraph.

Claims 1-13 and 15 stand rejected under 35 U.S.C. §102(b) over Whiteside ('177). With respect to the method claims, the Examiner states that "Whiteside ... discloses ... installing the fixture onto a distal femur which references i.e., refers to or indicate [sic], the non-prominent condyle or trochlear region (see Fig. 20) and resecting the femur in accordance with a reference or indication made by the fixture." However, Whiteside simply states, at column 9, lines 53-55 that:

"The cutting guide surface 83 (not shown) is in position to remove the desired amount of bone (approximately the thickness of the distal portion of the femoral prosthesis component)."

Accordingly, Whiteside is entirely silent with regard to referencing *any* feature of the distal femur, regardless of whether such features include condyles or trochlear region. In addition, if Whiteside were to reference the non-prominent condyle or trochlear region, more bone would be removed from the most prominent condyle than the thickness of the prosthesis to be inserted, which is contrary to the statements just cited.

With regard to apparatus claim 12, Applicant is fully aware that functional limitations do not necessarily limit structural claims, and that an Examiner is entitled to compare structural limitations of the prior art for the purposes of rejecting an apparatus claim. However, claim 12 includes a limitation of a fixture including a movable member which references one of non-prominent condyles or trochlear regions (as amended), a feature which Whiteside clearly does not have. Referencing Figure 20 of Whiteside, for example, even if element 18 could be moved down on rod 36 to contact the area between the condyles, since the surface of element 82 is integrally formed to the unit 80, this would lead the

surgeon to saw the bone at a point which is so far up the distal femur that more bone would be resected than possibly desired. The reason is that the apparatus of Whiteside clearly is not intended for referencing a non-prominent condyle or trochlear region as claimed by Applicant, and the cutting surface is not movable relative to the apparatus. Note, further, that claim 12 includes a limitation that the cutting guide is used to resect a femur in accordance with the reference made using the fixture, a structural arrangement which is absent in the Whiteside patent.

Claims 8-13 stand rejected under 35 U.S.C. §102(b) over White ('656). Although the White patent does disclose a reference guide 91, this is used to measure the anterior-posterior thickness of the distal femur to determine the cuts for a particular size implant, and has nothing to do with measuring the distal extent of either condyle or the trochlear region. Reference is made to Figure 11 of White, for example, which clearly shows the way in which the reference guide 91 is used on the anterior side of the bone. In addition, reference is made to column 9, lines 34-39, where it is explained that:

“... valgus module 61, 63, 65 [is] moved proximately until the planar face portion 30 of the distal aspect of butting surface 29 abuts the distal aspect 19 the distal femur 13.”

Accordingly, such a structure cannot possibly contact either the non-prominent condyle or trochlear region.

Based upon the foregoing, Applicant believes all claims are in condition for allowance. Any questions should be directed to Applicant's below-signed representative at the telephone and/or facsimile numbers provided. Attached is a version showing the changes made to the amended claims.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADEIN THE CLAIMS

12. (Amended) Apparatus for resecting a distal femur having prominent and non-prominent condyles separated by a trochlear region, comprising:

a fixture including a movable member which references one of [the] a non-prominent condyle or [and] trochlear region [regions]; and

a cutting guide to resect the femur in accordance with the reference made using the fixture.

13. (Amended) The apparatus of claim 12, wherein the fixture further includes:

an intramedullary rod; and

[a reference guide] wherein the member is movable on the rod.

14. The apparatus of claim [13] 12, wherein the fixture further includes a medial-to-lateral slide to which the reference guide attaches, enabling either condyle or the trochlear region to be used as *mpu* a reference for subsequent resection.